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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MARCUS J. ANDREWS,  
FIRDOSH K. BHESANIA,  
DORON J. HOLAN,  
ROBERT INGMAN,  
SCOTT R. LEATHAM,  
ERVIN PERETZ,  
KENNETH D. RAY, OM K. SHARMA  
and JAMES E. VERES

Appeal No. 2004-0498  
Application 09/497,914

ON BRIEF

Before THOMAS, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-53, which are all of the claims pending in the present application.

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The disclosed invention relates to a user input device which uses a structure called a genre for facilitating operation of the input device with various types of software applications. A genre description for a specific genre includes mappings that correlate input controls with actions to be performed in a particular application, the actions and controls defined in terms of labels or semantics. According to Appellants, their invention allows an application program to be decoupled from the particular vocabulary generated by a particular input device as indicated by the examples at pages 24-33 of the specification which describe genres that have semantics but do not include a command lexicon for a particular application.

Claim 1 is illustrative of the invention and reads as follows:

1. A game control device that conforms to Universal Serial Bus (USB) device class definitions for Human Interface Devices (HIDs), comprising:

a plurality of human-actuated controls;

one or more HID descriptors that describe aspects of the human-actuated controls, the HID descriptors associating HID string indexes with the respective human-actuated controls;

control mappings corresponding to a plurality of application program genres, the control mapping indicating actions to be performed in application programs of particular genres in response to respective ones of the human-actuated controls, wherein the control mapping identify controls by their HID string

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indexes, each of said genres comprising a set of semantics and not including commands interpretable by the application programs.

The Examiner relies on the following prior art:

|                                |           |                       |
|--------------------------------|-----------|-----------------------|
| Greanias et al. (Greanias)     | 5,157,384 | Oct. 20, 1992         |
| Tannenbaum et al. (Tannenbaum) | 5,442,376 | Aug. 15, 1995         |
| Kou                            | 6,085,265 | Jul. 04, 2000         |
|                                |           | (filed Jan. 09, 1998) |

Claims 3, 14, 23, and 36 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Tannenbaum and Greanias.<sup>1</sup> Claims 4-13, 15-22, 24-31, and 37-53 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Tannenbaum and Greanias in view of Kou. Claims 1, 2, and 32-35 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Kou in view of Tannenbaum and Greanias.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 16) and Answer (Paper No. 17) for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into

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<sup>1</sup> As noted by both Appellants and the Examiner, Greanias is incorporated by reference into Tannenbaum.

consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1-53. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 3, 14, 23, 32, 36, and 45, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by any of the applied prior art references. In particular, Appellants contend (Brief, pages 7-9) that none of the applied prior art references teaches or suggests the claimed genres, the characteristics of which are recited in each of the appealed independent claims 1, 3, 14, 23, 32, 36, and 45 as "comprising a set of semantics and not including commands interpretable by the application programs . . . ."

After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Brief. Although the Examiner has attempted to assert correspondence between the user profile 107 in Greanias and the claimed genres, we agree with Appellants that, in direct contrast to the language of the appealed claims, Greanias has a specific disclosure which indicates that the user profile 107 in fact contains commands which are interpretable by the application programs. As described at column 8, lines 1-14 and column 8, line 65 through column 9, line 8, of Greanias, the user profile clearly contains commands which are interpretable by the application programs and are passed to the application programs through environmental link 104. Further, Greanias, in discussing application profiles and user profiles, states at column 9, lines 17-20, that "[b]oth types of profiles associate a list lists [sic] of input messages with a list of corresponding commands which are recognized by the appropriate application program . . . ."

We recognize that the Examiner, in the "Response to Argument" portion of the Answer has restated the position related to the alleged correspondence of the user profile 107 in Greanias and the claimed genres by directing attention to columns 11 and

12 of Greanias which describe the situation in which the user profile is checked to see whether a command is inhibited.

According to the Examiner (Answer, pages 13-15), since certain commands present in the user profile of Greanias may be inhibited from being sent to the application program, the user profile therefore includes commands that are not interpretable by the application program.

It is apparent to us, however, that the Examiner has not properly interpreted and addressed the claim language of the appealed claims. Even assuming, arguendo, that the Examiner is correct in the assertion that an inhibited command is a non-interpretable command, a user profile, i.e., a genre, that includes some commands which are inhibited from being interpreted by an application program would not satisfy the present claim language which excludes any genre that contains any application program interpretable commands. In this same sense, and taking the Examiner's proffered interpretation to the extreme, the only conceivable situation in which the user profile in Greanias could possibly be construed to satisfy the claimed limitations is if such user profile only contained commands which are inhibited from being passed to the application programs. In our view, such a situation, aside from the absence of any such disclosure in

Greanias, would be clearly impractical and would reduce the user profile to the point of uselessness.

We have also reviewed the Tannenbaum reference which, as previously noted, incorporates Greanias by reference. We find nothing in the disclosure of Tannenbaum which overcomes the deficiencies of Greanias discussed supra. As pointed out by Appellants (Brief, page 7), Tannenbaum, as does Greanias, describes a user profile which links events with corresponding commands that are understood, i.e. interpreted, by a target object or application program. Similarly, our review of the Kou reference, applied by the Examiner to address the USB and HID descriptor features of several of the appealed claims, finds nothing which would overcome the innate deficiencies of Greanias and Tannenbaum.

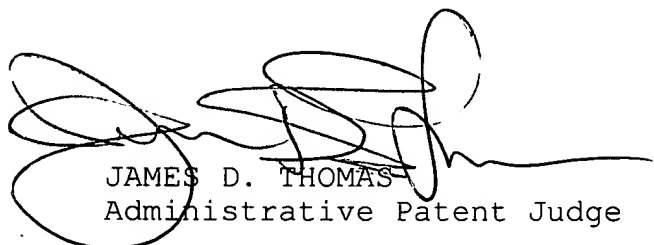
In summary, since all of the claim limitations are not taught or suggested by the applied prior art, it is our opinion that the Examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 3, 14, 23, 32, 36, and 45, nor of claims 2, 4-13, 15-22, 24-31, 33-35, 37-44, and 46-53 dependent thereon.




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Therefore, the Examiner's decision rejecting claims 1-53 is reversed.

REVERSED

  
JAMES D. THOMAS  
Administrative Patent Judge )

  
LEE E. BARRETT  
Administrative Patent Judge )

  
JOSEPH F. RUGGIERO  
Administrative Patent Judge )

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